

REMARKS

Favorable reconsideration of the present application is respectfully requested.

Claims 17-19, 22, 24, 28 and 30-32 have been cancelled. Only the originally patented Claims 1-16, 20, 21, 23 and 25-27 are pending in the application, and all stand rejected in view of the prior art.

I. REJECTION UNDER 35 U.S.C. § 112

The rejection under 35 U.S.C. § 112, second paragraph (paragraph 1 of the Office Action) is believed to be moot in view of the cancellation of Claim 18.

II. PRIOR ART REJECTIONS

[Paragraph 2] Claims 1, 20 and 25 were rejected under 35 U.S.C. § 102 as being anticipated by Salzman. However, the cross country ski boot of Salzman has an integrally molded upper and lower sole. The liner 50 is secured “over the inner surface of the sole section and upper section” (col. 3, lines 55-58). The liner 50 is consequently situated inside the upper section 12 of the boot and is not part of the outer sole. There is no description that the liner 50 is a comfort layer having shock absorption properties, or is “part of the sole being surmounted by the upper.” Thus Salzman does not anticipate the claims.

[Paragraph 4] Claims 1, 2, 4-14, 21 and 25 were rejected under 35 U.S.C. § 103 as being obvious over Misevich in view of Hannibal, wherein the Examiner has relied upon Hannibal to suggest extending the stiffening layer of Misevich to cover the entire surface of the ground contact layer. However, this is respectfully traversed. Initially, it is noted that the

plate 37 of Misevich is buried in the mid-sole 44-46, and so is not in contact with the ground contacting layer. Moreover, Misevich et al explicitly describes that the limited extent of the plate 37 is critical to its functioning: "Because of the *selected* area covered by the plate 37, however, the plate does not interfere with the required flexure of the shoe for running, walking or other normal activities" (col. 6, lines 43-46; emphasis added). Misevich et al thus *teaches against* the invention: that a greater area of coverage for the plate 37 would interfere with the required flexure of the shoe and is undesirable.

The element 30 of Hannibal is simply an inner sole. Also, it is separated from the comfort layer and is not arranged directly between the comfort layer and the ground contact layer. In any case, those skilled in the art would not have found it obvious from the inner sole of Hannibal to have modified Misevich in a manner *contrary to the teachings thereof*. That is, since Misevich et al teaches against extending the plate 37, those skilled in the art would not have been motivated by element 30 of Hannibal to have ignored this contrary teaching in the art. MPEP § 2141.02. As both Misevich et al and Hannibal teach providing a comfort layer between the plate 30 or 37 and the ground comfort layer, their combination *teaches away* from providing an intermediate plate directly in contact with the ground contact layer. Thus, no proper combination of the above references would anticipate or render obvious the subject matter of any of the claims.

[Paragraph 5] Claim 3 was rejected under 35 U.S.C. § 103 as being obvious over any of the previously applied references, and further in view of Banich, which was cited to teach providing a mid-sole having zones of different material properties. However, whatever teaching Banich may have in this respect, it would not overcome the shortcomings of the

primary references as discussed above, and so no combination of the above references would have rendered obvious the subject matter of any of the claims.

[Paragraph 6] Claims 23, 26 and 27 were rejected under 35 U.S.C. § 103 as being obvious over any of the previously applied references, and further in view of Kurrash which was cited to teach attaching tread elements to an intermediate support layer. However, whatever teaching Kurrash may have in this respect, it would not overcome the shortcomings of the primary references as discussed above, and so no combination of the above references would have rendered obvious the subject matter of any of the claims.

III. OBJECTIVE EVIDENCE OF UNOBVIOUSNESS

The Examiner must consider objective evidence of unobviousness. MPEP § 716.01(a). Such evidence can include evidence of commercial acquiescence such as licensing (*Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopaedics, Inc.* 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992)), and evidence of copying (*Panduit Corp. v. Dennison Mfg. Co.*, 774 F.2d 1082, 227 USPQ 337 (Fed. Cir. 1985), *vacated & remanded*, 475 U.S. 809, 229 USPQ 478 (1986), *on remand*, 810 F.2d 1561, 1 USPQ2d 1593 (Fed. Cir. 1987), *cert. denied*, 481 U.S. 1052 (1987)). Applicants are hereby submitting the declaration of Anne Laurent who is employed in the Legal and Industrial Property department of Salomon, S.A., which is the assignee of the above referenced application, as objective evidence of unobviousness. According to the Laurent declaration:

1. A competitor, Wolverine World Wide of Rockford Michigan, commercialized certain "Exotech" sport shoes after the issuance of U.S. patent 6,079,125. The "Exotech"

sport shoes incorporated a rigid insert placed between a cushioned mid-sole and an outer sole layer to enhance lateral stability and diffuse stress at impact points. This is evidence of copying of the patented intermediate layer which provides stability and the distribution of shock and stresses, and so constitutes evidence of unobviousness.

2. Wolverine has agreed to cease manufacture of the "Exotech" footwear and to submit certain redesigned footwear to Salomon for pre-approval as part of a settlement of litigation in Germany and litigation over U.S. patent 6,079,125 in the U.S. Applicants respectfully submit that this is evidence of commercial acquiescence and of unobviousness.

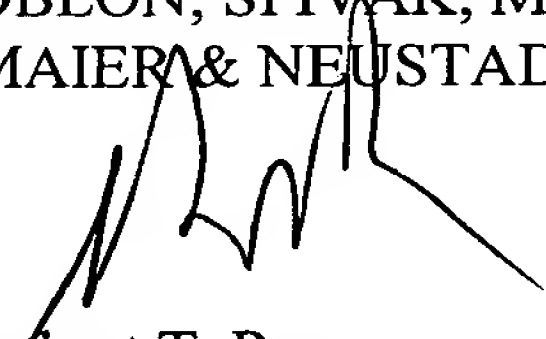
3. Another competitor, "One Sport," has filed a patent application which was published as WO 96/04811. WO 96/04811 exhibits a three layer construction including an intermediate stiffener 36. This technology has been commercialized by Montrail, particularly in their Traverse GTX and Blue Ridge GTX shoes (Exhibit B of the declaration). Yet other competitors, "Ecco," "Columbia," "Garmont," "Nike," "TSL," "Vasque" and "Zamberlan" have also recently commercialized a shoe having a three layer construction including an intermediate stiffener directly in contact with the ground contact layer. This is also evidence of copying and unobviousness.

Serial No.: 09/994,059
Reply to Office Action dated March 8, 2005

Applicants therefore believe that the present application is in a condition for
allowance and respectfully solicit an early notice of allowability.

Respectfully submitted,

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I:\rtp\216196US-am June '05